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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Bridon *et al.*

Confirmation No.: 7359

Application No.: 10/722,733

Art Unit: 1648

Filed: November 25, 2003

Examiner: Zachariah Lucas

For: LONG LASTING SYNTHETIC
GLUCAGON LIKE PEPTIDE (GLP-1)

Attorney Docket No.: 11767-055-999
(CAM: 515319-999055)

**SECOND REQUEST FOR RECONSIDERATION OF
DECISION ON PETITION UNDER 37 C.F.R. § 1.182**

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants received from the United States Patent and Trademark Office (“USPTO”) a Decision on the Request for Reconsideration of Decision on Petition Under 37 C.F.R. § 1.182 dated December 19, 2008 (“the December 19, 2008 Decision”). The December 19, 2008 Decision dismissed Applicants’ Request for Reconsideration of Decision on Petition Under 37 C.F.R. § 1.182 filed on October 31, 2008 (“the October 31, 2008 Request for Reconsideration”), which requested reconsideration of the Decision on Petition Under 37 C.F.R. § 1.182 dated September 2, 2008 (“the September 2, 2008 Decision”). The September 2, 2008 Decision dismissed Applicants’ request made in the Petition Under 37 C.F.R. § 1.182 dated June 30, 2008 (“the June 30, 2008 Petition”) that the above-identified abandoned application be amended to recite the correct relationship to a prior-filed application to which priority is claimed under 35 U.S.C. § 120. Applicants hereby request a reconsideration of the December 19, 2008 Decision, and reiterate their request that U.S. Patent Application No. 10/722,733 (“the ’733 Application”) be amended to indicate that the ’733 application is a continuation-in-part, rather than a continuation, of prior-filed U.S. Patent Application No. 09/623,548 (“the ’548 Application”).

The September 2, 2008 Decision states that the ’733 Application failed to make a specific reference to the prior-filed ’548 Application, and that a petition under 37 C.F.R.

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§ 1.78 (a)(3) is required, since the '733 Application was filed after November 29, 2000. Applicants responded in the October 31, 2008 Request for Reconsideration that a petition under 37 C.F.R. § 1.78(a)(3) is not necessary because a claim for the benefit of priority to the '548 Application, though not indicating the correct relationship to the '548 Application, was nonetheless included in both the Application Data Sheet (ADS) and Preliminary Amendment filed concurrently with the '733 Application on November 25, 2003, and this benefit claim was recognized by the USPTO as shown by its inclusion on the filing receipt for the '733 Application. In response, the December 19, 2008 Decision states that the priority claim made on the filing date of the '733 Application was incorrect because both the specification and the ADS stated that the present application "claims priority to US Application No. 09/623,548." The December 19, 2008 Decision further states that "the change that petitioner is attempting to make is not merely a correction of the relationship" (the December 19, 2008 Decision at page 2). Thus, the USPTO contends that although the USPTO indicated on the filing receipt for the '733 Application that the '733 Application is a continuation of the '548 Application, the Applicants failed to properly state *any* relationship between the '733 Application and the '548 Application, and therefore, a petition under 37 C.F.R. § 1.78(a)(3) is required to state the correct relationship.

In the present paper, and as discussed in a telephone conversation on January 6, 2009 between Mr. Clifford Congo, USPTO Petitions Attorney, and Mr. Wayne Szeto, an Attorney for Applicants, Applicants point out that an indication of the relationship between the '733 Application and the '548 Application was provided at the time of filing the '733 Application. A "Request to Transfer Sequence Listing From Related Applications" ("the Request to Transfer Sequence Listing") was filed on November 25, 2003 concurrently with the '733 Application; a copy of the Request to Transfer Sequence Listing is submitted herewith as Exhibit 1. The Request to Transfer Sequence Listing states in relevant part (at page 1):

Applicants assert that the present application is a continuation of U.S. Application Serial Nos. 10/288,340 and 09/623,548 so the transfer is appropriate.

Thus, an indication of the relationship was set forth in transmittal papers accompanying the filing of the '733 Application.

The fact that the relationship was indicated on the Request to Transfer Sequence Listing filed concurrently with the '733 Application, rather than in the Preliminary Amendment or Application Data Sheet for the '733 Application, does not mean that it should

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not be considered as providing the indication of relationship necessary to a timely filed benefit claim under 35 U.S.C. § 120. M.P.E.P 201.11 (V) (page 200-69, Eighth Edition, Revision 5, August 2006) provides:

If an applicant includes a claim to the benefit of a prior application elsewhere in the application but not in the manner specified in 37 C.F.R. 1.78(a)(2)(i) and (a)(2)(iii) or 37 C.F.R. 1.78(a)(5)(i) and (a)(5)(iii) (e.g., if the benefit claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in 37 C.F.R. 1.78(a)(2)(ii) or (a)(5)(ii), the Office will not require a petition and the surcharge under 37 C.F.R. 1.17(t) to correct the benefit claim if the information concerning the benefit claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt.

As noted above, the USPTO recognized the relationship to the priority cases as set forth in the Request to Transfer Sequence Listing, by including the relationship in the filing receipt of the '733 Application, which indicates that the '733 application is a continuation of the '548 Application, consistent with the information included in the Request to Transfer Sequence Listing. Therefore, pursuant to M.P.E.P 201.11 (V), amendment of the '733 application to correct the benefit claim to the '548 Application, *i.e.*, to indicate that the '733 application is a continuation-in-part, rather than a continuation, of the '548 Application, should not require submission of a petition under 37 C.F.R. § 1.78 (a)(3).¹

Applicants emphasize that amendment of an abandoned application to correct a priority claim is proper under *Sampson v. Commissioner of Patents and Trademarks*, 195 U.S.P.Q. 136 (D.D.C. 1976), and is properly petitionable under 37 C.F.R. § 1.182 (*see* the June 30, 2008 Petition, page 3). Where, as in the instant application, the benefit claim of an application *does* contain a specific reference to a prior application in compliance with 35 U.S.C. § 120, and transmittal documents filed with the application make it clear what the relationship is to the prior-filed application, which relationship is recognized by the USPTO in a filing receipt, *Sampson* provides the authority to amend the application after

¹ M.P.E.P 201.11 (V) (page 200-70, Eighth Edition, Revision 5, August 2006) states in relevant part:

A petition under 37 CFR 1.78(a)(3) and the surcharge would not be required for correcting a timely submitted benefit claim for the following situations:

- (A) Changing the relationship of the applications (e.g., changing from "continuation" or "divisional" to "continuation-in-part" or from "continuation-in-part" to "continuation" or "divisional"); ...

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abandonment to amend the priority claim,² while M.P.E.P 201.11 (V) makes it clear that a petition under 37 C.F.R. § 1.78 (a)(3) is not required to accompany such an amendment.

In view of the foregoing, Applicants respectfully request reconsideration of the USPTO's December 19, 2008 Decision. In particular, Applicants reiterate their request to amend the '733 application to correct the priority claim to the '548 application, and for entry of the Supplemental Application Data Sheet submitted with the June 30, 2008 Petition. While not conceding the propriety of the USPTO's December 19, 2008 Decision, Applicants reserve the right to submit a petition under 37 C.F.R. § 1.78 (a)(3) to amend the priority claim to indicate that the '733 application is a continuation-in-part of the '548 Application, in the event that this second Request for Reconsideration is denied.

Applicants also note that a Revocation and Power of Attorney and Statement under 37 C.F.R. 3.73(b) was filed with the June 30, 2008 Petition, requesting that all correspondence for the above-identified application be addressed to the following:

Jones Day
222 East 41st Street
New York, New York 10017

Applicants respectfully request that the correspondence address for the above-identified application be updated in the records of the USPTO.

Applicants believe that no fee is due for this request. Should any fee be required, however, please charge such fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Date: February 5, 2009

For: Adriane M. Antler (Reg. No. 32,605)



59,672

(Reg. No.)

JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939

² Sampson states in relevant part: "A reading of § 120 makes it clear that an amendment may be entered in an abandoned application for purposes other than prosecution." 195 U.S.P.Q. at 137 (citation omitted).

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Exhibit 1:
Request to Transfer Sequence Listing From Related Applications



PATENT
Docket No. 500862001601
Cl. Ref. REDC-16

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

Express Mail Label No.: EL968417752US

Date of Deposit: November 25, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to: MS Patent Application, Commissioner for Patents, P.O. Box 1450, Alexandria, VA. 22313-1450.



Victoria Wilson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Dominique BRIDON et al.

Serial No.: Not Yet Assigned

Filing Date: Concurrently Herewith

For: LONG LASTING SYNTHETIC
GLUCAGON LIKE PEPTIDE (GLP-1)

Examiner: Not Yet Assigned

Group Art Unit: Not Yet Assigned

**REQUEST TO TRANSFER SEQUENCE LISTING
FROM RELATED APPLICATIONS**

MS Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request that the Sequence Listing in both computer readable form (CRF) and paper copy from U.S. Application Serial Nos. 10/288,340 and 09/623,548 be transferred to the attached new U.S. Continuation Patent Application.

Applicants assert that the present application is a continuation of U.S. Application Serial Nos. 10/288,340 and 09/623,548 so the transfer is appropriate.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **500862001601**. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: November 25, 2003

By:


Cameron A. King
Registration No. (41,897)

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